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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,467	01/05/2004	Douglas S. Ransom	6270/105	4908

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EXAMINER

RODRIGUEZ, PAUL L

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/752,467	RANSOM ET AL.	
	Examiner	Art Unit	
	Paul L. Rodriguez	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed 12/19/05 has been received and considered. Claims 1-49 are presented for examination.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: Paragraph 50 line 10 recites "211 (not shown)", however reference 211 is shown in figure 2a. Appropriate correction is required.

#### ***Claim Objections***

3. Claims 19, 20, 26 and 49 are objected to because of the following informalities:

Claim 19 lines 6-7 state "said outbound communication", previously "outbound communications" see claim 19 lines 4-5.

Claim 19 lines 8-9 state "said outbound communication", previously "outbound communications" see claim 19 lines 4-5.

Claim 19 lines 9-10 state "said outbound communication", previously "outbound communications" see claim 19 lines 4-5.

Claim 20 lines 2-4 state "said outbound communication", previously "outbound communications" see claim 19 lines 4-5.

Claim 26 line 2 recites "communication-is", inadvertent use of "-".

Claim 49 line 19 states "said outbound communication", previously "outbound communications" plural.

Claim 49 line 20 states "said at least one secured inbound communications", previously "...communication".

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Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 25 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Kertesz et al (U.S. Pat 5,764,155). The claimed invention reads on Kertesz et al as follows:

Kertesz et al discloses an energy management device (reference number 122, 142) and a method of communicating by an energy management device (claim 1) for use in an energy management architecture (figure 2, 3) for managing an energy distribution system (abstract) said energy management architecture comprising a network (reference numbers 126, 128) said energy management device comprising an energy distribution system interface operative to couple said energy management device with at least a portion of said energy distribution system (figure 2, 3, col. 10 lines 10 – col. 11 line 14, connects to devices which are in connection with the energy distribution system), a network interface operative to couple said energy management device with said network for transmitting outbound communications to said network and receiving inbound communications from said network (col. 6 lines 3-18, col. 10 lines 10 – col. 11 line 14) said inbound communications comprising first energy management data and said outbound communications comprising second energy management data (col. 6 lines 3-34, it is inherent that inbound would be measured data from devices and outbound would be control or other data), a processor coupled with said network interface and said energy distribution system interface

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(inherent to reference number 122, 142 would contain a processor, col. 4 lines 30-43, figure 29, col. 14 lines 44-51) said processor operative to perform at least one energy management function on said at least said portion of said energy distribution network via said energy distribution system interface (col. 10 lines 52-55, collection of data is at least one management function), said processor further operative to process said first energy management data and generate said second energy management data as a function of said energy management function (col. 11 line 15 – col. 12 line 5), wherein at least one of said inbound communications comprises a secured inbound communications (col. 6 lines 10-18, col. 47 lines 1-11), said network interface further comprising a security module operative to secure said outbound communications and validate said at least one secured inbound communications (figure 4, 32, DDE server, col. 11 lines 15-52, col. 19 line 10 – col. 24 line 67, specifically col. 21 line 66 – col. 22 line 45, col. 34 lines 32-42, figures 90-96, examiner considers the DDE server to include a security function for secure communication and provides CRC check validation). Examiner would like to point out that any reference to specific figures, columns and lines should not be considered limiting in any way, the entire reference is considered to provide disclosure relating to the claimed invention. The claims given a broad reasonable interpretation and are therefore anticipated by Kertesz et al.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-14, 16-24, 26-37 and 39-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kertesz et al (U.S. Pat 5,764,155).

Kertesz et al teaches most all of the instant invention as applied to claims 1, 25 and 49 above. Kertesz et al fails to teach specific forms of encryption, authentication, transmission, retransmission, Pretty Good Privacy, public keys, secure mail, signatures, etc.

Official notice is taken that network and computer based communications using security measures was well known at the time the invention was made in analogous art of Milsted et al (U.S. Pat 6,263,313), Clawson (U.S. Pat 6,112,304) and Reed et al (U.S. Pat 5,862,325), not to mention that the U.S. Patent and Trademark office has established in the art classifications an entire class dedicated to secure data communications between computing devices (class 713/150-181). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to develop secure communications between processor based devices communicating on a data network because security measures were all well known in the art of data networks and data processor communications.

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Therefore, it would have been obvious to modify Kertesz et al to obtain the invention as specified in claims 2-14, 16-24, 26-37 and 39-48.

8. Claims 15 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kertesz et al (U.S. Pat 5,764,155) in view of official notice as applied to claims 2-14, 16-24, 26-37 and 39-48 above, and further in view of Bisbee et al (U.S. Pub 2001/0002485).

Kertesz et al in view of official notice teaches an energy management device with various security configurations as recited in claims 2-14, 16-24, 26-37 and 39-48 for the reasons above, differing from the invention as recited in claims 15 and 38 in that their combined teachings are silent on XHTML and XML signing.

Bisbee et al teaches XHTML and XML signing (paragraph 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the XHTML and XML signing for secure data communications of Bisbee et al in the energy management device of Kertesz et al, because the Bisbee et al teaches numerous security advantages and specifically that the use of XHTML and XML signing can be applied recursively, to provide signature and protection layering, improving security of communications (paragraph 19).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12, 27, 29 (as filed and prosecuted 43, 58 and 60) of U.S. Patent 6,990,395, Application No. 10/689,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

The claims of patent 6,990,395, application 10/689,895 contain every element of claims of the instant application and as such anticipates claims 1 and 49 of the instant application. *In re Goodman*, 29 USPQ2d 2010 (CAFC 1993)

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

11. Claims 1, 25 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 126, 127 (as filed and prosecuted 248-250)



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for claims 1 and 49 and over claims 83, 97 (as filed and prosecuted 212, 243) of U.S. Patent 6,961,641, Application No. 09/723,564. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

The claims of patent 6,961,641, application 09/723,564 contain every element of claims of the instant application and as such anticipates claims 1, 25 and 49 of the instant application.

*In re Goodman*, 29 USPQ2d 2010 (CAFC 1993)

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Response to Arguments***

12. Applicant's arguments filed 12/19/05 have been fully considered but they are not persuasive.

Regarding the drawing objections, the amendment corrected all deficiencies and the objections are withdrawn.

Regarding the specification objections, one deficiency remains, all previous objections withdrawn.

Regarding the rejections under 112 2<sup>nd</sup>, the amendment to the claims corrected most deficiencies, however claim objections remain.

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Regarding the rejection under 102. Applicant argues that Kertesz fails to teach “a security module”. While the Examiner previously relied upon the Gateway 150, which applicants arguments address, the Examiner now relies upon the DDE Server to support the rejection, vice the Gateway 150. Figure 4 and 32, which provide the software contained in the computer 122, 142, is used to perform secure data communications. Therefore, the Examiner now relies upon elements present in reference numbers 200-208 to support a security module.

Applicant argues that Kertesz fails to disclose second energy management data. Examiner disagrees, the DDE server receives data from field devices, considered to read on the first energy management data and then send data to requesting clients, the sent data is considered to read on a second energy management data. Reference numbers 122 and 142 monitor and control the architecture, if data is monitored and collected, and that data is later sent in response to a request, what is considered by the Examiner as the second management data is a function of the energy management function of the system. Col. 4 lines 27-43 clearly disclose that the DDE server communicates with field devices (considered the collection of first management data) and a client to respond to requests (considered the second management data).

Applicant argues that it is unclear whether Kertesz discloses an energy distribution system interface. It is the Examiners position that it is clear that Kertesz monitors and controls energy management distribution system and col. 4 lines 27-31 clearly shows the servers connection to field devices which are part of the energy management distribution system. The claims recite, “an energy distribution system interface operative to couple said energy management device with at least a portion of said energy distribution system. Connection to the field devices is considered to read on this limitation. The Examiner considers it clear that, via

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the multiple network connections, either Modbus or Ethernet, there are operative couplings to at least a portion of the energy distribution system via elements such as 130-136. Therefore, the interface cards of 122 and 142 do provide an operative interface with the distribution system.

Regarding the rejection under 103, applicant argues that analogous art fails to disclose the securing module. As addressed above, the DDE server run on 122 and 142 are considered to contain a security module.

Therefore it is the Examiners position that Kertesz does anticipate the independent claims and the rejections are maintained.

Examiner would like to point out that the applicant failed to respond in any way to the Double Patenting rejections made by the Examiner. Therefore the rejections are maintained and restated above.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

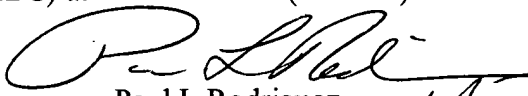
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L. Rodriguez whose telephone number is (571) 272-3753. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul L Rodriguez  
Primary Examiner  
Art Unit 2125  
2/10/06

PLR  
9/15/05